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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,661	03/24/2004	Richard E. Staerzl	M09741	4313
7590	12/29/2005			EXAMINER
William D. Lanyi Mercury Marine W6250 Pioneer Road P.O. Box 1939 Fond du Lac, WI 54936-1939			SWINEHART, EDWIN L	
			ART UNIT	PAPER NUMBER
			3617	
			DATE MAILED: 12/29/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/807,661	STAERZL, RICHARD E.
	Examiner	Art Unit
	Ed Swinehart	3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 October 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-37 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for measuring voltage a distance from the housing must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura (5716248).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guinn.

Guinn discloses the claimed invention, including an anode which forms a housing for receipt of a metal plate 152. All being attached to the lower unit of a marine propulsion unit, which is attached to a transom.

Re "causing", the mere placement of the device in water meets this limitation.

Re "providing a source of electrical power", it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a battery to the propulsion unit of Guinn, to permit starting thereof. The claim does not recite the connection of the battery to anode.

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Re claim 2, the lower unit and the anode mounting plate inherently become cathodes in such a circuit.

6. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Showcatally.

Showcatally discloses an anode **20** which houses the propeller shaft, and which is attached to a metallic member in the form of propeller **28**.

7. Claims 1-9,14-24 and 29-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Staerzl '472 in view of Klimowicz.

Staerzl teaches provision of a housing structure (hull) having an electrical conductive coating. Staerzl fails to disclose an adaption for transom mounting.

Klimowicz teaches the mounting of a watercraft to the transom of a larger watercraft.

It would have been obvious to one of ordinary skill in the art at the time of the invention to transport the craft of Staerzl upon the transom of a larger craft as taught by Klimowicz.

Such a combination would have been desirable at the time of the invention so as to provide ease in transport.

Re "housing structure for said marine propulsion unit", a ship inherently includes propulsion equipment, such as an engine, and the hull houses such an engine.

Re claims 5-7,19-22,32, such is accorded no weight in the claim as such is directed towards apparatus, while the claim is method.

Re claim 16, such fails to define over the other half of the ship's hull.

Re claim 8, such is inherent since the hull halves of Staerzl are insulated from each other.

8. Claims 1-3 and 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Staerzl '460 in view of Klimowicz.

Staerzl shows a marine propulsion unit housing 11, given a positive potential (therefore inherently anode). A voltage is sensed at reference point 13, and such sensed voltage is used to control the operation of the device.

Apparatus limitations are treated as above.

Klimowicz is applied as above.

9. Claims 10-13, 25-28 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staerzl '472 in view of Klimowicz as applied against claims 1-9,14-24 and 29-34 above, and further in view of Staerzl '460.

Staerzl '472 fails to mention the measuring of voltage as claimed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide for control of the system of '472 as taught by '460, and provide for measurement of potential voltage.

Such a combination would have been desirable at the time of the invention so as to provide additional control.

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ed Swinehart whose telephone number is 571-272-6688. The examiner can normally be reached on Monday through Thursday 6:30 am to 2:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ed Swinehart
Primary Examiner
Art Unit 3617